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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/332,273	06/11/1999	BERNARD S. MIENTUS	AVERP2168US	2718

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EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/332,273	Applicant(s) MIENTUS ET AL.	
	Examiner Elena Tsouy	Art Unit 1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 81-85, 87-89, 91-95, 97-99, 101-104, 107-110, 113, 115-118.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: PTO-892 Notice of References Cited

Advisory Action

1. The Reply under Rule 1.116 to the final rejection filed October 27, 2003 has been considered but is not deemed to place the application in condition for allowance for the reasons of record as set forth the Final Office Action mailed on August 2003 (Paper No. 24).

Response to Arguments

2. Applicants' arguments filed October 27, 2003 have been fully considered but they are not persuasive.

(A) Applicants argue that Mueller and Josephy et al are not combinable because the Examiner's extension of the term "specific applications" of Mueller to include any application such as label or sign is unwarranted and unsupported since "specific applications" of Mueller relate to applications as shrinkable films only, that are useful in packaging (column 1, line 9) whereas Josephy et al is concerned with oriented and annealed films which are not shrinkable and are useful in label manufacture so that Mueller and Josephy et al are directed to different technology.

First of all, Applicants' statement that oriented and annealed films are not shrinkable is not correct. One of ordinary skill in the art at would know that oriented and annealed films are still shrinkable, as evidenced by Rackova (See column 26, lines 10-15).

Secondly, one of ordinary skill in the art at would know that shrinkable films, that are useful in packaging, and shrinkable labels are directed to the same technology. Look at

Fujio (US 5,421,932, column 1, lines 21-24);

Hostetter (US 5,460,878, column 2, lines 44-45);

JP 05208447 (See title);

JP 05305667 (See Abstract).

(B) Applicants argue that claimed invention is not obvious over Mueller in view of Josephy et al because films of Muelleris are shrink films and claimed films are unoriented. The Examiner's reliance on Josephy et al is an example of hindsight reasoning resulting from a reading of Applicant's specification.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Josephy et al teach that polyolefin blend films are resistant to abrasion when extruded, but such resistance is degraded when the film is uniaxially oriented following extrusion. Extruded non-stretched films achieve *high abrasion-resistance ratings*, although their MD stiffness is too low for proper dispensing. See column 10, lines 43-59. In other words, Josephy et al teach that the same film can be used either in oriented form or unoriented depending on intended use of a final product.

Therefore, a reconstruction is proper, since the Examiner's conclusion of obviousness is based upon knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure.

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Art Unit: 1762

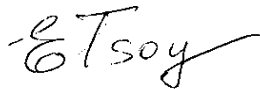
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Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on Mo-Thur. 9:00-7:30, Mo-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Elena Tsoy
Examiner
Art Unit 1762

November 4, 2003